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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,734	08/18/2003	Philippe Richard	2872-003	4101
75671 7590 08/18/2009 Sadler, Breen, Morasch & Colby, ps 422 W. Riverside Ave, Suite 424 Spokane, WA 99201				
EXAMINER KIM, JUNG W				
ART UNIT 2432		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/643,734

Applicant(s)

RICHARD, PHILIPPE

Examiner

JUNG KIM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 33-56 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-13 and 33-56 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date 3/25/09
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the amendment filed on 4/23/09.
2. Claims 1-13 and 33-56 are pending.

Information Disclosure Statement

3. The IDS submitted on 3/25/09 has been considered. An initialed copy is enclosed.

Response to Amendment

4. The 112 rejection of claims 7 and 39 are withdrawn in view of the amendment to the claims.

Response to Arguments

5. Applicant's arguments with respect to the 101 rejections are not persuasive. See 101 rejections below.
6. Applicant's arguments with respect to the prior art rejections of the amended claims have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude"

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granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1, 2, 13, 33, 34, 44, 45 and 56 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 7,124,435. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of claims 1, 2, 13, 33, 34, 44, 45 and 56 are defined in claims 1-8 of patent 7,124,435.

Claim Rejections - 35 USC § 101

9. Claims 33-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 33-43 are directed to an article of manufacture including but not limited to a signal bearing medium. This new preamble is deficient for the following reasons: although the preamble

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defines "an article of manufacture including but not limited to a signal bearing medium," the limitation "an article of manufacture" is merely a signifier for a category of invention that does not identify the scope of an article of manufacture, i.e. a claim for an "article of manufacture" can be any and all creations by man. As such, the limitation "an article of manufacture" by itself is meaningless in determining whether the claimed invention is statutory. For example, a claim defined as "an article of manufacture comprising a signal" is clearly not one of the four statutory categories of patent eligible subject matter. See *In re Nuijten*. To determine the meets and bounds of the claimed invention, the limitation "an article of manufacture" must be interpreted with respect to the limitations defined in the remainder of the claim. In this case, nothing in the claim suggests any boundaries for the article of manufacture except that it stores instructions and is capable of being executed by a discovery machine. However, one of ordinary skill in the art would recognize that a signal stores instructions and is capable of being executed by a discovery machine. Hence, claims 33-43 remain rejected under 101.

Claims Rejections – 35 USC § 102

10. Claims 1, 2, 4, 6-8, 10, 11, 13, 33, 34, 36, 38-40, 42-45, 47, 49-51, 53, 54 and 56 are rejected under 35 U.S.C. 102(e) as anticipated by Fernando et al. US 7,386,878 (hereinafter Fernando).

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11. As per claims 1, 2, 4, 6-8, 10, 11 and 13, Fernando discloses a method comprising:

- a. determining by said discovery machine whether a first user associated with a first client machine will accept a communication from said second user (col. 6:5-13, first user sends the encrypted session key and the first user public key to the central server when the first user accepts the request from the second user);
- b. if said first user will accept said communication, establishing a direct link between said first client machine and said second client machine to deliver said communication wherein if established said direct link is configured such that said communication is not delivered through said discovery machine and wherein no direct link is established if said first user will not accept said communication;
- c. Wherein said direct link is closed after said communication is delivered (when the session ends, the session key expires);
- d. Wherein a new direct link is established between said second client machine and said first client machine to communicate a new communication (each successive session requires a new link);
- e. Wherein at least one of said first user and second user maintains a plurality of contact information; wherein an individual entry in said plurality of contact information is automatically updated if an associated user of said individual entry locally at a client machine of said associated user

(4:20-23, instant messaging applications provide updateable contract lists);

f. Wherein a third user can initiate a new communication to at least one of said first and said second user via a web page interface coupled to said discovery machine (4:25-35, peer authentication applies to connections between all peers in the framework);

g. Wherein at least one of said first user and second user can selectively block said new communication (6:9-13, replying peer must respond to initiating peer request);

h. Wherein a one-directional communication link is sent to said third user when at least one of said first user replies to said new communications and wherein said one-directional communication allows said third user to send a future communication directly to said first or second user (once the session key is exchanged, direct peer communication is enabled for the session);

i. Wherein said discovery machine is a central server (fig. 1, reference 106).

12. As per claims 33, 34, 36, 38-40, 42 and 43, they are claims corresponding to claims 1, 2, 4, 6-8, 10, 11 and 13, and they do not teach or define above the information claimed in claims 1, 2, 4, 6-8, 10, 11 and 13. Therefore, claims 33, 34, 36, 38-40, 42 and 43 are rejected as being anticipated by Fernando for the same reasons set forth in the rejections of claims 1, 2, 4, 6-8, 10, 11 and 13.

13. As per claims 44, 45, 47, 49-51, 53, 54 and 56, they are claims corresponding to claims 1, 2, 4, 6-8, 10, 11 and 13, and they do not teach or define above the information claimed in claims 1, 2, 4, 6-8, 10, 11 and 13. Therefore, claims 44, 45, 47, 49-51, 53, 54 and 56 are rejected as being anticipated by Fernando for the same reasons set forth in the rejections of claims 1, 2, 4, 6-8, 10, 11 and 13.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 3, 35 and 46 are rejected under 35 U.S.C. 103(a) as being obvious over Fernando.

16. As per claim 3, the rejection of claim 1 under 35 USC 102(e) as being anticipated by Fernando is incorporated herein. Although Fernando does not expressly disclose wherein if said first user is not available to receive said communication, said communication is stored by said discovery machine until said first user becomes available, it is notoriously well known in the networking art to temporarily store a communication until a receiving end becomes available.

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For example, connection oriented communications require that a receiver respond to a connection request before any communication is transmitted; typically, communications are temporarily stored until a response is received or the request times out. Official notice of this teaching is taken. Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Fernando to perform the step of storing the communication by said discovery machine until said first user becomes available if said first user is not available to receive said communication. One would be motivated to do so to ensure that the first user actually receives the communication. The aforementioned cover the limitations of claim 3.

17. As per claim 35, it is a claim corresponding to claim 3, and it does not teach or define above the information claimed in claim 3. Therefore, claim 35 is rejected as being unpatentable over Fernando for the same reasons set forth in the rejections of claim 3.

18. As per claim 46, it is a claim corresponding to claim 3, and it does not teach or define above the information claimed in claim 3. Therefore, claim 46 is rejected as being unpatentable over Fernando for the same reasons set forth in the rejections of claim 3.

19. Claims 5, 9, 12, 37, 41, 48, 52 and 55 are rejected under 35 U.S.C. 103(a) as obvious over Fernando in view of Olkin et al. US 6,584,564 (hereinafter Olkin).

20. As per claims 5, 9 and 12, the rejection of claims 1 and 4 under 35 USC 102(e) as being anticipated by Fernando is incorporated herein. Although the Fernando disclosure is directed to an IM service between peers, Fernando discloses that the teachings of their invention is not limited to IM services, and further Fernando envisions that a variety of other types of communication-oriented servers and clients may be employed. See col. 4:20-35. Olkin discloses a secure e-mail system, whereby a central security server, which is separate from a central e-mail server, enables a receiver to decrypt messages encrypted by a sender. Col. 3:42-4:24. However, in the invention of Olkin, messages are transmitted by a sender to a receiver regardless of whether the receiver is willing to accept the message, thereby burdening the network with unwanted e-mail transmissions when the receiver is unwilling to accept the communication. Col. 7:1-14. The invention of Fernando as applied to the invention of Olkin alleviates this problem by requiring the receiving peer to indicate whether the peer is willing to accept the communication by the sending peer. Fernando, col. 6:9-13. Therefore, the invention of Fernando as modified by the invention of Olkin suggest the limitations: wherein a thread of related pervious communications is prefixed to said new communication (e-mails conventionally include prior responses); wherein a third user can initiate a new communication to at least one of said first and second user through a simple mail-transfer protocol via said discovery machine (SMTP is the standard for e-mail; Official notice of this fact is taken); and wherein determining that said first

user will accept said communication includes storing notification of said communication if said first user is unavailable (SMTP reply code 550, e-mail unavailable). One would be motivated to do so to transmit the e-mail message only when the receiving party is willing to accept the message to reduce network traffic and to limit the number of unwanted e-mails sent to a receiver. The aforementioned cover the limitations of claims 5, 9 and 12.

21. As per claims 37 and 41, they are claims corresponding to claims 5, 9 and 12, and they do not teach or define above the information claimed in claims 5, 9 and 12. Therefore, claims 37 and 41 are rejected as being unpatentable over Fernando in view of Olkin for the same reasons set forth in the rejections of claims 5, 9 and 12.

22. As per claims 48, 52 and 55, they are claims corresponding to claims 5, 9 and 12, and they do not teach or define above the information claimed in claims 5, 9 and 12. Therefore, claims 48, 52 and 55 are rejected as being unpatentable over Fernando in view of Olkin for the same reasons set forth in the rejections of claims 5, 9 and 12.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Communications Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W. Kim whose telephone number is 571-272-3804. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jung Kim/
Primary Examiner, AU 2432